Attorney Docket No.: 42P15784

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS

In Re Application of:	
Brickell, et al.	Examiner: Truvan, Leynna Thanh
Application No.: 10/686,343	Art Unit: 2435
Filed: October 14, 2003	Confirmation No: 7197
For: METHOD FOR SECURELY DELEGATING TRUSTED PLATFORM MODULE OWNERSHIP	

Assistant Commissioner For Patents
Board of Patent Appeals and Interferences
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO EXAMINER'S ANSWER

Pursuant to 37 C.F.R. § 41.41, and in response to the Examiner's Answer dated November 30, 2009, Applicant submits the attached Reply Brief.

I hereby certify that this correspondence is being deposited via EFS Web on the date below:

January 28, 2010
Date of Deposit

/Gigi Hoover/
Gigi Hoover

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I. STATUS OF CLAIMS

Claims 1-2, 4-10, 12-18 and 20 are pending in the present application.

Claims 3, 11 and 19 have been canceled.

No Claims have been allowed.

Claims 1-2, 4-10, 12-18 and 20 have been finally rejected under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 103(a) in the Final Office Action mailed December 23, 2008.

Claims 1-2, 4-10, 12-18 and 20 are the subject of this appeal. A copy of Claims 1-2, 4-10, 12-18 and 20 as they stand on appeal is set forth in Appendix A.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-2, 4-10, 12-18 and 20 are unpatentable under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 103(a) as being unpatentable over Lambert in view of Challener.

III. ARGUMENT

Claims 1-2, 4-10, 12-18 and 20 are pending in the above-referenced patent application, of which claims 1, 9 and 17 are independent claims. These independent claims are the main subject of this Appeal. These claims were finally rejected in the Final Office Action mailed December 23, 2008 (hereinafter "office action") under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and under 35 U.S.C. § 103(a) as being unpatentable over US 7,350,204 to Lambert et al. (hereinafter Lambert) in view of US 7,194,762 to Challener et al. (hereinafter Challener).

Claims 1-2, 4-10, 12-18 and 20 rejection under 35 U.S.C. §112, first paragraph

Claims 1-2, 4-10, 12-18 and 20 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

In the Examiner's Answer to Appellants' Appeal Brief, the Examiner removed the rejection of claims 1-2, 4-10, 12-18 and 20 under 35 U.S.C. §112, first paragraph.

The Appellants respectfully acknowledge the removal of the rejection of claims 1-2, 4-10, 12-18 and 20 under 35 U.S.C. §112, first paragraph.

Claims 1-2, 4-10, 12-18, and 20 rejection under 35 U.S.C. §103(a)

Claims 1-2, 4-10, 12-18, and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lambert in view of Challener.

Independent claims 1 and 9, from which claims 2, 4-8, 10 and 12-16 depend, include the feature, "*the delegated environment is an environment* ***to which the master owner token is not communicated***." Independent claim 17, from which claims 18 and 20 depend, recites a similar feature.

The Examiner's Answer relies solely on Lambert to disclose the portion of the claims that state, i.e. to anticipate the feature, "*wherein the delegated environment is an environment to which the master owner token is not communicated.*" However, Lambert fails to anticipate this feature. Citing § 2131.01 of the M.P.E.P.,

> ""A claim is anticipated only if each and every element as set forth in the claim is found, **either expressly or inherently described**, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." (§ 2163 of the M.P.E.P. Emphasis added.)

Thus, if a single reference is used reject an element of a claim, that single reference must disclose the element either expressly or inherently. Lambert does neither. The Examiner's Answer states, Lambert "*does not suggest the parent token is communicated to the delegated environment since the focus is the restricted token that is associated to a process/software.*" (*See*

Examiner's Answer, p. 6, last paragraph.) However, **the lack of suggestion referred to by the office action is certainly not an explicit disclosure** that the parent token of Lambert is not communicated to the delegated environment, because it is not stated explicitly that this is the case. Furthermore, **the lack of suggestion in Lambert is also not an inherent disclosure** that the parent token of Lambert is not communicated to the delegated environment, because none of the technical features disclosed by Lambert would enable restriction of the parent token of Lambert from being communicated to the delegated environment. Accordingly Lambert fails to disclose "*wherein the delegated environment is an environment to which the master owner token is not communicated*," as taught and claimed by the Appellants.

Challener is relied on merely to disclose "*a method and system for improved security password-based access to computer networks*," including the use of "*a Trusted Platform Module*." (*See* Examiner's Answer, p. 7, second paragraph.) As such, Challener fails to cure the above-noted deficiencies of Lambert. Thus, **neither Lambert nor Challener, alone or in combination, discloses "the delegated environment is an environment to which the master owner token is not communicated,"** as taught and claimed by the Appellants.

IV. CONCLUSION

For at least the reasons stated above, claims 1-2, 4-10, 12-18 and 20 are patentable. Appellant respectfully requests that the Board reverse the rejections of claims 1-2, 4-10, 12-18 and 20 under U.S.C. § 103(a) and direct the Examiner to enter a Notice of Allowance for claims 1-2, 4-10, 12-18 and 20.

Appellant believes that no fee is required for consideration of this reply brief, as the fee of $540.00 to cover the appeal fee for one other than a small entity as specified in 37 C.F.R. §1.17(c) was submitted with the originally filed brief. Please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Date: January 28, 2010

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